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09/886,334	06/21/2001	Kael Duaine Burden	BURD-0275	5412

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SCHMEISER OLSEN & WATTS
18 E UNIVERSITY DRIVE
SUITE # 101
MESA, AZ 85201

EXAMINER

GRAHAM, CLEMENT B

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,334

Applicant(s)

BURDEN, KAEI DUAINE

Examiner

Clement B Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 32-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 32-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims, 1-17 and 32-44 remained pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-17, and 32-44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris U.S Patent 6, 105, 007 in view of Henochowicz et al (Hereinafter Henochowicz U.S Patent 5, 252, 811).

As per claim 1-5, 10, Norris disclose an investment machine for public use and display, the investment machine. ("i. e, Kiosk") comprising:

- a. housing.(see column Fig: 2)
- b. a display at least partially enclosed by the housing and viewable by an investor .("i. e, applicant ") adjacent to the housing.(see Fig: 2 and see column 3 lines 45-60 see column 9 lines 5-55)
- c. an investor identifier at least partially enclosed within the housing and configured to receive a unique identifier from the investor.(see column 3 lines 45-60 see column 8 line 5) and
- d. a money receiver at least partially enclosed within the housing .(Note fig: 2 and see column 9 line 65 and column 10 line 5)
- e. a processor at least partially enclosed within the housing. (see column 9 lines 5-60) and configured to receive money to be invested. (see column 9 line 65 and column 10 line 5) input from the investor. ("i. e, applicant") representative of the investor's current preferences ("i. e, "mutual funds, savings bonds", or certificates of deposits" see column 3 line 60 and column 9 line 65 and column 10 line 5") for investing the money and to transmit a signal representative of the input for use in investing at least a portion of the money in association with the unique identifier received from the investor.(see column 9 lines 5-55).

Norris fail to explicitly teach configured to receive and count money in the form of at least one of a bill and coin to be invested.

However Henochowicz discloses participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting, recordation of deposited amount, periodic collection and investment interest-bearing savings accounts or bonds on behalf of the small investor/depositor.(Note abstract and see column 11 lines 8-17 and column 3 line 67-68 and column 4 lines 1-25).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include configured to receive and count money in the form of at least one of a bill and coin to be invested taught by Henochowicz in order to encourage participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting.

As per claim 6, Norris disclose a network communication connection is further configured to couple the processor of the investment machine to the central processor at substantially the same time as the investor identifier receives the unique identifier from the investor.(see column 9 lines 5-55).

As per claim 7, Norris disclose to teach the display is configured to display at least one of investment information, advertising information, and account information.(see column 3 lines 45-60).

As per claim 8, Norris fail to teach the advertising information is selected on the basis of one or more of an investor's investment activities, an investor's personal information, a location at which the investment machine is located and an identity of a sponsor of the investment machine.

However advertising information based on investor's investment activities, an investor's personal information, a location at which the investment machine is located and an identity of a sponsor of the investment machine of the investment machine is old

and well known in the art of advertising because investment advertising is most likely used to target a specific group of investors with a investment history.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include advertising information selected on the basis of one or more of an investor's investment activities, an investor's personal information, a location at which the investment machine is located and an identity of a sponsor of the investment machine because investment advertising is most likely used to target a specific group of investors with a investment history.

As per claim 9, Norris fail to teach advertising information is one or more of an informational presentation, a tutorial, a news story, and other information relating to a particular company or its product in which an investor may desire to invest.

However advertising information is one or more of an informational presentation, a tutorial, a news story, and other information relating to a particular company or its product in which an investor may desire to invest is old and well known in the art because an individual can acquire advertising information through a host of ancillary investment news, information, advice, and counseling.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include to include advertising information being one or more of an informational presentation, a tutorial, a news story, and other information relating to a particular company or its product in which an investor may desire to invest because an individual can acquire advertising information through a host of ancillary investment news, information, advice, and counseling and further these information are used to attract customers for resulting in a financial gain of an institution.

As per claim 11, Norris disclose an investment report. ("i. e, documents") disburse ("i. e, printer") associated with the processor and configured to disburse a report associated with the investor's unique identifier.(See column 4 line 35).

As per claim 12-13, Norris disclose a method of investing money, the method comprising:

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associating a unique identifier with at least one person.(see column 3 lines 45-60) receiving current investment preferences. ("i. e, mutual funds, savings bonds, or certificates of deposits" see column 3 line 60 and column 9 line 65 and column 10 line 5) through the investment machine from the at least one person and investing at least a portion of the money on behalf of the at least one person in accordance with the current investment preferences.(see column 9 lines 5-55).

Norris fail to explicitly teach receiving money in the form of least one of a bill and a coin directly at an investment machine from the at least one person.

However Henochowicz discloses participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting, recordation of deposited amount, periodic collection and investment interest-bearing savings accounts or bonds on behalf of the small investor/depositor.(Note abstract and see column 11 lines 8-17 and column 3 line 67-68 and column 4 lines 1-25).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include teach receiving money in the form of least one of a bill and a coin directly at an investment machine from the at least one person taught by Henochowicz in order to encourage participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting.

As per claim 14, Norris fail to explicitly teach receiving at least one of an indication from the investor that an investment option provided by the processor is preferred, an investment option pre-selected by the investor is preferred, and an investment option provided by the investor at the time of the indication is preferred.

However it would have been obvious upon receiving an investment option from an investor that this selection would have been is preferred choice and an investment option provided by the processor is preferred, an investment option pre-selected by the

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investor is preferred, and an investment option provided by the investor at the time of the indication is preferred because the investor would have to research his option prior to making his selection before making a preferred decision or choice.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include receiving at least one of an indication from the investor that an investment option provided is preferred, an investment option preselected by the investor is preferred, and an investment option provided by the investor at the time of the indication is preferred because the investor would have to research his option prior to making his selection before making a preferred decision or choice.

As per claim 15, Norris disclose inputting a unique identifier ("i. e, signature see column 9 line 5-55 and column 3 lines 45-60") an investment machine. ("i. e, Kiosk") and selecting a current investment preference option at the investment machine. (see column 9 lines 30-35 and column 3 lines 45-60).

Norris fail to explicitly teach placing money in the form of least one of a bill and a coin directly to be invested into the investment machine.

However Henochowicz discloses participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting, recordation of deposited amount, periodic collection and investment interest-bearing savings accounts or bonds on behalf of the small investor/depositor. (Note abstract and see column 11 lines 8-17 and column 3 line 67-68 and column 4 lines 1-25).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include placing money in the form of least one of a bill and a coin directly to be invested into the investment machine taught by Henochowicz in order to encourage participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting.

As per claim 16, Norris disclose receiving an investment report.("i. e, documents") from the investment machine.(see column 4 lines 30-35).

As per claim 17, Norris disclose the money receiver is configured to receive one or more of a coin, a bill, a magnetic strip card, a bar code, a smart card and an alphanumeric code.(see column 9 lines 5-55).

As per Claim 32, Norris disclose inputting a unique identifier ("i. e, signature see column 9 line 5-55 and column 3 lines 45-60") an investment machine("i. e, Kiosk") placing money to be invested into the investment machine.(see column 9 line 65 and column 10 line 5) selecting a current investment preference option at the investment machine.(see column 9 line 30-35)

As per claim 33, Norris disclose receiving an investment report.("i. e, documents") from the investment machine.(see column 4 lines 30-35).

As per claim 34, Norris fail to teach providing at least one of an indication that an investment option provided is preferred and an indication that a preselected investment option is preferred.

However it would have been obvious upon providing at least one of an indication that an investment option provided is preferred and an indication that a preselected investment option is preferred because the investor would have to research his option prior to making his selection before making a preferred decision or choice.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include receiving at least one of an indication from the investor that an investment option provided is preferred, an investment option preselected by the investor is preferred, and an investment option provided by the investor at the time of the indication is preferred because the investor would have to research his option prior to making his selection before making a preferred decision or choice.

As per claim 35-39, Norris disclose an investment machine for public use and display, the investment machine. ("i. e, Kiosk") comprising:
a housing.(see column Fig: 2)

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a display at least partially enclosed by the housing and viewable by an investor .("i. e, applicant ") adjacent to the housing.(see Fig: 2 and see column 3 lines 45-60 see column 9 lines 5-55)

an investor identifier at least partially enclosed within the housing and configured to receive a unique identifier from the investor.(see column 3 lines 45-60 see column 8 line 5) and

processor configured to receive and count money to be invested.(Note fig: 2 and see column 9 line 65 and column 10 line 5) and processor at least partially enclosed within the housing. (see column 9 lines 45-60) and configured to receive input from the investor indicative of the investor's current investment preferences.(see column 9 lines 30-35) and to transmit a signal representative of the input for use in investing at least a portion of the money. (see column 3 lines 45-60) in association with the unique identifier received from the investor.(see column 3 lines 45-60 and column 5 lines 45-55).

Norris fail to explicitly teach at least one of a coin receiver and a bill receiver at least partially enclosed within the housing.

However Henochowicz discloses participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting, recordation of deposited amount, periodic collection and investment interest-bearing savings accounts or bonds on behalf of the small investor/depositor.(Note abstract and see column 11 lines 8-17 and column 3 line 67-68 and column 4 lines 1-25).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include placing money in the form of least one of a bill and a coin directly to be invested into the investment machine taught by Henochowicz in order to encourage participation of small investors in savings accounts and investment accounts, particularly, this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting.

As per claim 40, Norris disclose a network communication connection is further configured to couple the processor of the investment machine to the central processor at substantially the same time as the investor identifier receives the unique identifier from the investor.(see column 9 lines 5-55 and column 14 lines 35-40).

As per claim 41, Norris disclose the display is configured to display at least one of investment information, advertising information, and account information.(see column 3 lines 45-60).

As per claim 42, Norris fail to teach the advertising information is selected on the basis of one or more of an investor's investment activities, an investor's personal information, a location at which the investment machine is located and an identity of a sponsor of the investment machine.

However advertising information based on investor's investment activities, an investor's personal information, a location at which the investment machine is located and an identity of a sponsor of the investment machine of the investment machine is old and well known in the art of advertising because investment advertising is most likely used to target a specific group of investors with a investment history.

As per claim 44, Norris disclose an investment report. ("i. e, documents") disburse ("i. e, printer") associated with the processor and configured to disburse a report associated with the investor's unique identifier.(See column 4 line 35).

As per claim 43, Norris fail to teach advertising information is one or more of an informational presentation, a tutorial, a news story, and other information relating to a particular company or its product in which an investor may desire to invest.

However advertising information is one or more of an informational presentation, a tutorial, a news story, and other information relating to a particular company or its product in which an investor may desire to invest is old and well known in the art because an individual can acquire advertising information through a host of ancillary investment news, information, advice, and counseling.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Norris to include to include advertising information being one or more of an informational presentation, a tutorial, a

news story, and other information relating to a particular company or its product in which an investor may desire to invest because an individual can acquire advertising information through a host of ancillary investment news, information, advice, and counseling and further these information are used to attract customers for resulting in a financial gain of an institution.

Conclusion

Response to Arguments

5. Applicant's arguments files on 7/15/04 have been fully considered but they are not persuasive for the following reasons.

6. In response to Applicant's arguments as it pertains to Norris.

7. In response to Applicant's arguments that prior art fail to teach "money receiver to receive and identify or count money in the form of a coin or a bill" this limitation is disclosed by Henochowicz combination of teachings states this invention relates to coin and currency counting bank machines at which small amounts of coins and paper currency can be deposited for collection and for automatic accounting, recordation of deposited amount, periodic collection and investment interest-bearing savings accounts or bonds on behalf of the small investor/depositor Note abstract and see column 11 lines 8-17 and column 3 line 67-68 and column 4 lines 1-25. It is obviously clear from the combine teachings that a money receiver to receive and identify or count money in the form of a coin or a bill is being taught.

8. With respect to Applicant's argument, that the examiner fail to establish prima facie case of obviousness, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F. 2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ* 685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the

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combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 10). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App. &, 4/293). Therefore the combination of reference is proper and the rejection is maintained.

9. In response to applicant arguments against the references individually, one cannot show nonobviousness by attacking the reference individually where the rejections are based on a combination of references. See *In Keller*, 642 F.2d, 208 USPQ 871 (CCPA 1981); *In re Merk & Co.*, 800 F.2d 1091, 231 USPTQ 375 (Fed. Cir. 1986).

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

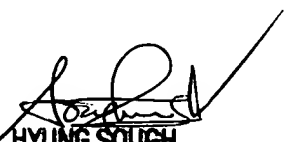
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

October 11, 2004


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600